

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

FUSN1-01045US0

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number

10/789,816

Filed

February 27, 2004

First Named Inventor

Onyon

Art Unit

2617

Examiner

Rampuria, S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Brian I. Marcus/

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Signature

Brian I. Marcus

Typed or printed name

☒ attorney or agent of record.  
Registration number 34,511

415-369-9660

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

November 9, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application	)	<u>PATENT APPLICATION</u>
	)	
Inventor(s): Onyon, et al.	)	
	)	Art Unit: 2617
Application No.: 10/789,816	)	
	)	Examiner: Rampuria, Sharad K.
Filed: February 27, 2004	)	
	)	
Title: WIRELESS TELEPHONE DATA BACKUP SYSTEM	)	<u>Customer No. 28554</u>
	)	

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REASONS FOR REQUESTING REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Rejection of Claims 1-15, 17, 20-45, 48-62 and 64-69 Under 35 U.S.C. 102(c)

Claims 1-15, 17, 20-45, 48-62 and 64-69 are rejected under 35 U.S.C. 102(c) as being anticipated by US Patent Application Publication No. 2004/0235523 to Schrire et al. ("Schrire"). As discussed below, applicants respectfully submit that the claims of the present invention include several limitations that are nowhere disclosed, taught or in any way suggested by Schrire. It is noted that, for a given claim, the absence of any one of the following limitations from Schrire is enough to overcome the rejection of that claim on the stated grounds. All claim limitations are significant, and must be given weight and effect vis-à-vis the patentability of the claims. *Application of Saether*, 492 F.2d 849, 852 (C.C.P.A. 1974). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

A. Back-Up System User Account Set-Up Interface

Each of the claims recite a back-up system user account set-up interface in one form or another. As a partial example:

- “presenting a back-up system user account set-up interface on a user interface on the phone, the set-up interface enabling establishment of a back-up service account.” (Claims 1-19)
- “presenting a back-up system user account set-up interface on a user interface on the phone... establishing a user account via the back-up system user account set-up interface, the user account identifying the user by an unique designation.” (Claims 30-41)
- “an automated user account creation method initiated by the user via a user interface on a wireless telephone, the creation method accessing the backup system using a unique identifier for the user to create a user account on the backup system.” (Claims 52-60)

As an initial matter, it is noted that the Examiner has cited to three different sections of Schrire in three different communications to support the position that the above-described limitation is shown in Schrire. In the Final Rejection dated August 11, 2006 (“the Final Rejection”), the Examiner indicated that this claim limitation was shown in Schrire at paragraphs 51 and 61. In a subsequent telephonic interview held August 28, 2006, after it was pointed out to the Examiner that paragraphs 51 and 61 do not support the stated rejection, the Examiner adopted the position that the above-described limitation was instead disclosed in paragraph 60 of Schrire. After it was pointed out to the Examiner in the Response after Final that paragraphs 51, 60 and 61 do not support the stated rejection, the Examiner adopted the position in the Advisory Action that the above-described limitation was instead disclosed in paragraph 267 of Schrire.

As the Examiner appears currently to rely on paragraph 267 of Schrire as showing the above-described limitations, applicants address that paragraph below. The reasons as to why paragraphs 51, 60 and 61 do not support the Examiner’s rejection are set forth in the Response after Final of record with the Patent Office.

In the Advisory Action, the Examiner states that Schrire discloses the above-identified limitations as follows:

Schrire supports [the above-identified claim limitations] as, the backup file 49 is substituted by a “changes to be backed up” file including a set of flags for each ADN record in the abbreviated dialing numbers file 36 indicating whether a user has input any changes to the record using the keyboard. Finally, a further file comprises a “Current Backup” file including flags for each record for indicating whether any changes have been made and have been included in the last backup data message which is currently in the buffer 38 or being transmitted by the mobile phone. (Emphasis in original).

This language is a quote of paragraph 267 from Schrire.

The above-quoted paragraph does not disclose or relate in any way to a user interface for setting up a user account as recited in the claims indicated above. The above paragraph relates to files and flags that are generated within a phone, invisible to the user, when a user makes changes to his or her contact information and the like stored on their phone. There is no disclosure of setting up a user account, and there is no disclosure of a user interface for setting up an account. These limitations are expressly recited in the claims and cannot be ignored. One of skill in the art reviewing the above paragraph, or any other portion of Schrire, would have no disclosure, teaching or suggestion of any kind of a user interface for setting up a user account as expressly recited in the claims indicated above.

B. Backup Scheduling Interface On The Phone

The claims further recite a backup scheduling interface in one form or another allowing a user to define his or her own desired schedule for backing up the mobile data. As a partial example, the claims recite:

- “presenting a backup scheduling interface to the user interface on the phone, the backup scheduling interface accepting user input on a backup schedule.” (Claims 1-19)
- “the agent including ... a backup method scheduling interface ... provided to a user interface on the phone.” (Claims 20-29)
- “an automated backup [process/method] transmitting changes to the backup system at user defined intervals.” (Claims 42-60)

Applicants again note as an initial matter that the Examiner has recited completely new grounds within Schrire which he alleges shows the above-identified limitations. In particular, in the Final Rejection, the Examiner cited to paragraphs 84 and 102 as showing the above-described limitations. After it was pointed out to the Examiner in the Response after Final that paragraphs 84 and 102 do not support the stated rejection, the Examiner adopted the position in the Advisory Action that the above-described limitation was instead disclosed in paragraph 131 of Schrire.

As the Examiner appears currently to rely on paragraph 131 of Schrire as showing the above-described limitations, applicants address that paragraph below. The reasons as to why paragraphs 84 and 102 do not support the Examiner’s rejection are set forth in the Response after Final of record with the Patent Office.

In the Advisory Action, the Examiner states that Schrire discloses the above-identified limitations as follows:

Schrire supports the [above-identified claim limitations] as, Rather than by periodically interrogating the address book data (i.e. EF.sub.ADN data) to look for changes as in the first embodiment, backup messages are initiated by entry of new ADN data via the keyboard of the mobile phone. Restore messages, as in the first embodiment, are instigated by a user request to the backup data service centre, whilst configuration messages will usually be instigated by the data backup service system operator. (Emphasis in original).

This language is a quote of paragraph 131 from Schrire.

At most, the above-described language indicates that address book data will be backed up when new address book data is entered into the phone using the keyboard. However, the above paragraph is completely silent as to a user setting a schedule for backing up the phone data, and the above paragraph is completely silent as to a user interface allowing a user to set a schedule for backing up the phone data. These limitations are expressly recited in the claims and cannot be ignored. One of skill in the art reviewing the above paragraph, or any other portion of Schrire, would have no disclosure, teaching or suggestion of any kind to provide a user interface for setting up a back up schedule as expressly recited in the claims indicated above.

C. A Restore Information Interface On The Phone  
Enabling A User To Retrieve Backup Information

The claims further recite a backup scheduling interface in one form or another allowing a user to define his or her own desired schedule for backing up the mobile data. As a partial example, the claims recite:

- presenting a restore information interface on the user interface on the phone, the restore interface enabling a user to retrieve backup information to a data store on the phone. (Claims 1-19)
- presenting a restore information interface on the user interface on the phone, the restore interface enabling the user to retrieve the phone data and changes to the phone data to a data store on the phone. (Claims 61-62 and 64-69)

In the Advisory Action, the Examiner states that Schrire discloses the above-identified limitations as follows:

Schrire supports the [above-identified claim limitations] as, Rather than by periodically interrogating the address book data (i.e. EF.sub.ADN data) to look for changes as in the first embodiment, backup messages are initiated by entry of new ADN data via the keyboard of the mobile phone. Restore messages, as in the first embodiment, are instigated by a user request to the backup data service centre, whilst configuration messages will usually be instigated by the data backup service system operator. (Emphasis in original).

This language is again a quote of paragraph 131 from Schrire.

As in the first embodiment disclosed in Schrire, this paragraph merely states that a restore operation is initiated by a user contacting the backup data service center. However, in Schrire, the contact with the customer service center is not accomplished using a restore interface on the phone:

In the event that the user requires restoration of the EF<sub>ADN</sub> data stored on the SIM card 8, due to, for example, loss of the SIM card or corruption of the data, this will normally be dealt with by the user contacting the customer service centre. An appropriate message will be sent through the customer service centre server 97 to the database server 83 to instigate the restore process either for all entries, or for a selected group of entries. In the event of the loss of the SIM card, this may conveniently be achieved by download of the data stored on the database 85 to a SIM manufacturer who is able to load the data. (Paragraph 113).

One of skill in the art reviewing the above paragraph, or any other portion of Schrire, would have no disclosure, teaching or suggestion of any kind to provide a user interface enabling a user to retrieve backup data as expressly recited in the claims indicated above.

Based on the above remarks, reconsideration of claims 1-62 and 64-69 is respectfully requested.

Respectfully submitted,

Date: November 9, 2006

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